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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/661,920   | 09/14/2000  | Wilson Moya          | MCA-474             | 9899             |
| 25182  | 7590        | 02/25/2005           | EXAMINER            |                  |
| MILLIPORE CORPORATION<br>290 CONCORD ROAD<br>BILLERICA, MA 01821 |             |                      | VO. HAI             |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1771                |                  |
| DATE MAILED: 02/25/2005  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/661,920

Applicant(s)

MOYA, WILSON

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,3,9-21 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,9-21 and 25-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Art Unit: 1771

1. The 102 art rejections over Moya et al (US 5,271,839) are withdrawn in view of the present amendment; however, upon further consideration, a new ground of rejection is made in view of the 102/103 art rejections over Moya et al (US 5,271,839).
2. The art rejections over Moya et al (US 5,271,839) in view of Wang et al (US 6,045,694) are considered moot in view of the cancellation of claims 22-24.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2, 3, 9-21, and 25-28 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The porous filtration structure made from a porous polymeric membrane which is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 2, 9, 11, 12, 14-16, 20, 21, 25, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Meyering et al (US 4,929,354). Meyering

teaches a filter element comprising a microporous filter membrane having a porous areas and non-porous areas that is made of the same polymeric material as the porous areas. The non-porous areas comprise collapsed and fused material of the porous membrane (figures 3, 4, 4a and 4b and column 12, lines 45-55). The microporous membrane is sandwiched between the inner and outer layer of polypropylene web netting (figure 3). The microporous membrane is laminated to another microporous membrane (column 11, lines 53-55). Meyering teaches a filter element having an integrally preformed non-porous sealing area by collapsing the porous of the membrane (column 12, lines 30-40). Likewise, the porous areas and non-porous areas of all the layers are in register with each other. The porous areas is longitudinal bordered by non-porous sealing areas (column 12, lines 30-40). The porous membrane is made from polyolefin (column 9, lines 25-30). It is the examiner's position that Meyering anticipates the claimed subject matter.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 3, 9, 11, 12, 14-21, and 25 and 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over

Art Unit: 1771

Moya et al (US 5,271,839). It is all appreciated that the claims are amended in a manner as suggested by the examiner. However, upon further consideration, the amendments are not sufficient to overcome the art rejections. The art rejections have been maintained for the following reasons. The limitations "non-porous areas comprise collapsed and fused material of the porous membrane layer and the non-porous material is formed of the porous material by a process comprising the steps of applying an energy selected from the group consisting of heat, pressure, softening and combinations thereof to the areas of the porous material in which the non-porous areas are desired in order to cause the porous material in the desired areas to collapse and become fused into non-porous material" mean that the non-porous areas are formed from the same polymeric material as the porous areas. Moya discloses the porous polymeric product comprising an intermediate layer of a non-porous material interposed between two surface layers comprising a patterned porous polymeric structure (column 6, lines 35-38). The pattern porous polymeric structure of Moya has the non-porous area and the porous area made from the same polymeric material shown in figures 9-13 (column 7, lines 40-55). Therefore, the claims are not structurally distinguished from the presently claimed patterned structure from the prior art.

Accordingly, Moya anticipates or strongly suggests the claimed subject matter.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moya et al (US 5,271,839) substantially as set forth in the 11/17/2004 Office Action. Moya does not specifically disclose the processing steps as recited by the claims.

However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the porous structure of Moya is identical to or only slightly different than the claimed porous patterned structure prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. The porous structure of Moya comprises an intermediate layer of a non-porous material interposed between two surface layers comprising a patterned porous polymeric structure (column 6, lines 35-38). The pattern porous polymeric structure of Moya has the non-porous area and the porous area made from the same polymeric material shown in figures 9-13 (column 7, lines 40-55). Although the product of Moya and the product of the present invention are made from different processes, the final structure of the two products are the same. Both comprise one or more layers of a porous membrane, each layer of the porous membrane having one or more porous areas and one or more non-porous areas wherein non-porous areas are made from the same material as the porous areas.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax

Art Unit: 1771

phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

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